

REMARKS

Claims 1-44 are pending. Claims 1-31 and 36-44 are canceled without prejudice. Claims 32-35 are rejected.

DOUBLE PATENTING

Claims 32-35 are rejected for obviousness-type double patenting over claims 2, 12, and 13 of U.S. Patent No. 6,706,254; and over claim 1 of U.S. Patent No. 6,395,257. Applicants attach a Terminal Disclaimer over the '254 patent. Applicants disagree there is double patenting over the '257 patent because claim 1 recites a "pharmaceutically acceptable carrier", while rejected claims 32-35 recite "a biocompatible organic solvent". Pharmaceutically acceptable carriers need not render obvious organic solvents, e.g., solubility differences, as known to one of ordinary skill in the art.

CLAIM REJECTIONS UNDER 35 U.S.C. §112

Claims 32-35 are rejected under 35 U.S.C. §112 ¶2 as indefinite.

Applicants disagree that the term "enhance" is indefinite. One of ordinary skill in the art knows that fluorescence is "enhanced" if any of its parameters (e.g., signal intensity, spectrophotometric absorbance, spectral shift, signal output, noise reduction, etc.) are greater when the biocompatible organic solvent at about 1% to about 50% is added to the dye, than when it is not added to the dye.

Claim 35 is amended as the Examiner indicated to render the claim definite.

For at least these reasons, Applicants assert the rejections are overcome and request their withdrawal.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 32-35 are rejected under 35 U.S.C. §102(b) as anticipated by Eversole.

Applicants, to their best knowledge, did not receive Eversole with the Office Action.

Applicants disagree with the rejection. Claims 32-35 recite a method using a biocompatible organic solvent at specified concentration ranges to enhance dye fluorescence. Eversole does not disclose this method; in contrast, Eversole discloses "a study involving microdroplet missing resonance spectroscopy", as the Examiner noted. Because at least this element is missing from Eversole, and because this element is required in Applicant's method, Eversole does not anticipate. For clarity, Applicants have amended claims 32-35 to recite that their method is performed in order to enhance dye fluorescence during the photodiagnostic or phototherapeutic procedure.

Claims 32-35 are rejected under 35 U.S.C. §102(b) as anticipated by Licha U.S. Patent No. 6,083,485. Claims 32-35 recite a method using a biocompatible organic solvent at specific concentration ranges to enhance dye fluorescence. Licha does not disclose this method. For clarity, Applicants have amended claims 32-35 to recite that their method is performed in order to enhance dye fluorescence during the photodiagnostic or phototherapeutic procedure. Because at least this element is missing from Licha, and this element is required in Applicant's method, Licha does not anticipate.

For at least these reasons, Applicants assert the rejections are overcome and request their withdrawal.

CONCLUSION

Applicants believe the application is in complete condition for allowance. The Terminal Disclaimer fee is the only fee believed due, which will be charged to credit card, if any other fees deemed necessary, fees may be charged to Deposit Account No. 20-0809.

The Examiner is invited to contact Applicants' undersigned representative with questions.

Respectfully submitted,

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